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First Named Inventor Sugio MAKISHIMA

Art Unit 2625

Examiner Name K. Y. Poon

Attorney Docket Number 0905-0266P


ENCLOSURES (Check all that apply)

☐ Fee Transmittal Form☐ Fee Attached☐ Amendment/Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Reply to Missing Parts/Incomplete Application☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a Provisional Application☐ Power of Attorney, Revocation Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) _____☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board of Appeals and Interferences☒ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☐ Other Enclosure(s) (please identify below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Signature 

Printed name Michael R. Cammarata

Date November 9, 2007

Reg. No. 39,491



Docket No.: 0905-0266P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sugio MAKISHIMA et al.

Application No.: 09/922,869

Confirmation No.: 8515

Filed: August 7, 2001

Art Unit: 2624

For: PRINT SYSTEM AND METHOD OF
CONTROLLING OPERATION OF SAME

Examiner: K. Y. Poon

REPLACEMENT
APPLICANT'S BRIEF IN REPLY TO THE EXAMINER'S ANSWER

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following brief is submitted to address the issues raised in the Examiner's Answer mailed September 18, 2007.

The Examiner's Answer mailed September 18, 2007, is difficult to interpret. As discussed below, it contains inconsistent arguments and relies on documents that are not of record to support the rejection of some or all claims. Furthermore, it appears that the Examiner's Answer includes new grounds of rejection in the "Response to Arguments" section. However, these are not specifically designated as new grounds of rejection and appear to be inconsistent with the rejections presented in the "Grounds of Rejection" section of the Examiner's Answer. The following Reply addresses only the rejections that are designated as rejections in the Examiner's Answer.

If the Board finds that new grounds of rejection are raised by the Examiner's Answer, it is respectfully requested that the Board remand this application to the examiner for a Supplemental Examiner's Answer pursuant to 37 C.F.R. 41.50. If the Supplemental Examiner's

Answer specifically designates new grounds of rejection, Applicant will consider possible claim amendments to overcome such any new grounds of rejection that are identified.

THE EXAMINER'S RELIANCE ON OFFICIAL NOTICE IS IMPROPER

The final Office Action and section 9 of the Examiner's Answer both provide that "it is well known in the art that things that are united solidly probably are under a same housing." This statement is presented in support of the rejection of claims 1-3, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg. Applicant challenged this reliance on Official Notice in the Appeal Brief. In the Section 10 of the Examiner's Answer, the examiner argues that he is not taking Official Notice of any fact but is relying on definitions from the web site www.dictionary.com to support the rejection. These definitions have not previously been mentioned, and copies of the definitions relied on are not of record. It is therefore respectfully submitted that this evidence cannot be relied upon to support the rejection of any claims.¹ It is further submitted that a proper basis for taking Official Notice has not been established, and that all rejections based on the above-quoted statement should be withdrawn.

The Examiner's Answer also includes the statement "the most efficient method of entering numbers (phone numbers) or letters (email address) is by using keypad...." It is respectfully submitted that this statement cannot be established by Official Notice. In fact, it would seem more efficient to enter letters by using a standard computer keyboard than by using the keypad of a telephone. Applicant therefore challenges the examiner's reliance on Official Notice to establish the truth of the above statement and submits that all rejections based on this statement should be withdrawn.

A MOTIVATION FOR MODIFYING TAMURA STILL HAS NOT BEEN PROVIDED

The final Office Action and section 9 of the Examiner's Answer reject claims 1-3, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg.

¹ To the extent evidence not of record is given any weight, it is noted that www.dictionary.com does not include a definition of "solidly." Only a definition of "solid" could be found by Applicant's representative, and of the 17 meanings of this word, the one selected by the examiner does not appear to be the most relevant to the present facts.

Applicant argued in the Appeal Brief that a proper motivation for modifying Tamura in view of these secondary references had not been provided. In section 10 of the Examiner's Answer, the examiner argues for the first time that the motivation for modifying Tamura comes from Tamura itself. This statement and the discussion that follows suggests the examiner may be making an anticipation rejection under 35 U.S.C. 102(b) based on Tamura or a new single reference obviousness rejection under 35 U.S.C. 103(a) based on Tamura. However, after presenting these arguments, page 10 of the Examiner's Answer refers once again to Parulski and Attenberg. It is not clear what modification to Tamura is being suggested and what role Parulski and Attenberg play in the rejection.

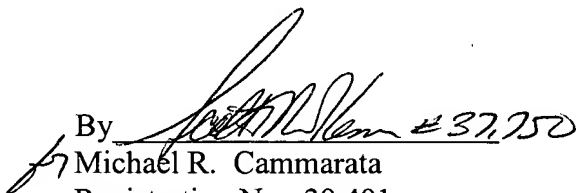
If the claims are still being rejected based on Tamura in view of Parulski and Attenberg, Applicant maintains that a proper motivation for combining these references has not been provided. If the examiner is raising a new rejection, it is respectfully submitted that the application should be remanded for a Supplemental Examiner's Answer that specifically designates any such new ground of rejection.

CONCLUSION

For the above reasons and the reasons presented in Applicant's Appeal Brief, the withdrawal of the rejections of claims 1-3 and 10-13 is earnestly solicited. If the examiner wishes to raise new grounds of rejection or rely on evidence not in the record, it is respectfully requested that the present application be remanded and prosecution reopened with appropriate guidance from the Board.

Dated: November 9, 2007

Respectfully submitted,

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